UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,971	09/16/2003	Zbigniew Tokarski	3216.23US01	2678

24113 7590 03/30/2005

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

EXAMINER	
RODEE, CHRISTOPHER D	
ART UNIT	**PAPER NUMBER**
1756	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/663,971	TOKARSKI ET AL.	
	Examiner	Art Unit	
	Christopher RoDee	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 and 27-30 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/5/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19 and 27-30, drawn to an azine compound, an organophotoreceptor containing the compound, and an apparatus containing the organophotoreceptor, classified in class 430, subclass 79.

II. Claims 20-26, drawn to an imaging process, classified in class 430, subclass 117.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in another and materially different process, such as charging the surface of the organophotoreceptor, exposing the photoreceptor to a laser light, contacting the exposed surface of the photoreceptor with a dry toner, fixing the toner to the surface of the photoreceptor, and contacting the fixed toner with a clear coversheet to form a permanent visible image.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Peter Dardi on 17 March 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19 and 27-30.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 and 27-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 & 22-25 of copending Application No. 10/760039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specific dimeric azine compounds disclosed in the copending claims identify compounds within the scope of the instant claims. For example, compound (11) disclosed in the copending application falls within the scope of the

claims of that invention and also falls within the scope of the instant claims. See MPEP 804(B)(1) for the propriety using the specification in an obviousness-type double patenting rejection. The copending claims also disclose an organophotoreceptor and an apparatus having these compounds as well as the other requirements of the claims. Consequently, it would have been obvious to select specific substituents and groups for each of the variables noted in the copending claims as disclosed by those claims, which results in compounds within the scope of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-19 and 27-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 & 29-35 of copending Application No. 10/832596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specific dimeric azine compounds disclosed in the copending claims identify compounds within the scope of the instant claims. For example, compounds (1) and (2) disclosed in the copending application fall within the scope of the claims of that invention and also fall within the scope of the instant claims. See MPEP 804(B)(1) for the propriety using the specification in an obviousness-type double patenting rejection. The copending claims also disclose an organophotoreceptor and an apparatus having these compounds as well as the other requirements of the claims. Consequently, it would have been obvious to select specific substituents and groups for each of the variables noted in the copending claims as disclosed by those claims, which results in compounds within the scope of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sakai *et al.* In US Patent 4,420,548 discloses hydrazone and ketazine compounds for use in organophotoreceptors but does not disclose the specific azine dimers of the instant claims. Tokarski *et al.* in US Patent Application Publication discloses azine dimmers, such as those of the formula (11), but is not available as prior art because the filing date of the application is after the filing date of the instant application. Tokarski's section 119(e) priority claim does not predate the filing date of the instant application because all of the groups corresponding to Y in Tokarski are fluorenone groups, which do not disclose or suggest the respective groups having a carbon atom attached to a disubstitutedarylamine as in the instant claims. The Chemical Abstracts citation discloses a dimeric azine compound but this compound does not have the requisite "X" groups of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
21 March 2005

CHRISTOPHER RODEE
PRIMARY EXAMINER